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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

January 9, 2003

In re Application of: Boire, Martin  
Serial No. 09/894,044  
Filed: June 28, 2001  
For: LABELER FOR PIPES, CONDUITS, TUBES AND RODS  
Examiner: William Miller  
Art Unit: 3677  
Confirmation Number: 6168  
Attorney Docket No.: BOI-1CIP

## REPLY TO OFFICE ACTION

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Washington, D.C. 20231

The office action of November 20, 2002 has been reviewed and its contents carefully noted. Reconsideration of this case, as amended, is requested. Claims 1 through 34 remain in this case.

The Restriction Requirement

The Examiner has made an election requirement and has identified thirteen groups as follows:

Group I- Figures 1A-1B, 2, 3A-3C.

Group II- Figure 4A.

Group III- Figure 4B.

CERTIFICATE OF CERTIFIED MAILING	
CERTIFIED MAIL NO: <u>2001 2510 0004</u> <u>7358 1345</u>	DATE: <u>1-9-03</u>
I hereby certify that this paper is being deposited with the U.S. Postal Service as Certified Mail with return receipt requested to Addressee service under 37 CFR 1.8 on the date indicated above and is addressed to Commissioner of Patents and Trademarks, Washington, D.C. 20231.  <u>Judy H. Barron</u> <u>Justin Wood</u> <u>Judy H. Barron</u>	

Group IV- Figure 5A.

Group V- Figure 5B.

Group VI- Figure 6.

Group VII- Figures 7A-7B.

Group VIII- Figure 8.

Group IX- Figure 9A-9B.

Group X- Figure 10A-10C.

Group XI- Figure 11.

Group XII- Figure 13.

Group XIII- Figure 14.

During the phone interview to the applicant's attorney on November 19, 2002, an election of species was not made. The election of Group XIII and the species defined by claims 1-28 and 32-33 is hereby made. This requirement for election as best understood is respectfully traversed.

The MPEP states the following with regard to stating a *prima facie* case of restriction between patentably distinct inventions:

"There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- 1) The inventions must be independent (see MPEP 802.01, 806.04, 808.01) or **distinct as claimed** (see MPEP 806.05-806.05(i)); and
- 2) There must be a **serious burden on the examiner** if restriction is not required (see MPEP 803.02, 806.04(a) - 806.04(j), 808.01(a) and 808.02).

## GUIDELINES

Examiners must provide reasons and/or examples to support conclusions, but need not cite documents to support the requirement in most cases. **Where plural inventions are capable of being viewed as related in two ways, both applicable criteria for distinctness must be demonstrated to support a restriction requirement.**..For purposes of the initial requirement a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02.” (MPEP 803)

All of the claims recite related inventions in that each recites a pipe labeler. All of the variations shown in the Figures would be searched under the same class and subclasses. Even if some of the inventions would be classified separately, a thorough search of the prior art for any one of the inventions would include the classes and subclasses of the other inventions.

Furthermore, when electing species, “where there is a relationship disclosed between species, such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.” (M.P.E.P. 808.01(a)). The Examiner neither discusses the disclosed relation or the reasons advanced leading to the conclusion that the relation should not prevent restriction. Therefore, the restriction is improper.

All of the Figures show variations of a pipe labeler of the invention. There is no burden on the Examiner to search any of the aspects of this invention. Therefore, the Applicant requests reconsideration and withdrawal of the election requirement.

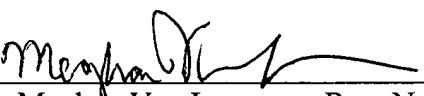
Applicant believes the claims are patentable over the prior art, and that this case is now in condition for allowance of all claims therein. Such action is thus respectfully requested. If the Examiner disagrees, or believes for any other reason that direct contact with Applicants' attorney would advance the prosecution of the case to finality, he is invited to telephone the undersigned at the number given below.

"Recognizing that Internet communications are not secured, I hereby authorize the PTO to communicate with me concerning any subject matter of this application

by electronic mail. I understand that a copy of these communications will be made of record in the application file."

Respectfully Submitted:

*Boire et al.*

By: 

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